



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/764,086	01/23/2004	James R. Thiessen	51600/RVW/J214	8550

23363 7590 05/04/2005

CHRISTIE, PARKER & HALE, LLP
PO BOX 7068
PASADENA, CA 91109-7068

EXAMINER

WRIGHT, DIRK

ART UNIT	PAPER NUMBER
----------	--------------

3681

DATE MAILED: 05/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/764,086

Applicant(s)

THIESSEN ET AL.

Examiner

Dirk Wright

Art Unit

3681

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-60 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-60 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>01232004</u> . | 6) <input type="checkbox"/> Other: ____ |

Specification

The use of the trademark Harley Davidson® has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner that might adversely affect their validity as trademarks.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 18-60 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The use of the phrase “a stock Harley Davidson® five speed transmission case” is indefinite because it is not known if there are more than one kind of five speed transmission from this manufacturer, and because what is considered a stock transmission case may change over the life of any patent that may issue from this application. It is also not clear whether or not applicant intends that his claimed invention include every five speed transmission ever produced by this manufacturer, the ones available at the time of filing this application, or for every future five speed transmission produced by this manufacturer. Even further, “stock” is not defined in the claims, thus it has no meaning and conveys no limitation therein. The term “trapdoor” is not defined in the claims, and while applicant may be his own lexicographer, and in spite of the fact that the term is defined in the specification as a cover, one of ordinary skill, upon reading the claim, would include traditional interpretations of that term to mean a hinged floor surface area

Art Unit: 3681

for the purpose of trapping someone in an area below the floor. Such an interpretation would render the claim confusing and therefore indefinite.

The examiner was not able to make a determination as to the patentability of the claims in light of the rejection under 35 U.S.C. 112, second paragraph.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Negherbon '125.

Negherbon shows all of the features recited in these claims, including a six-speed transmission with six pairs of gears on two shafts, with each rotatable gear is removably engaged by one of a plurality of shift rings 176, 280 and 234. The rings carrying dogs that engage pockets in the gears when a shift ring is moved into engagement with a gear. The terms “4th gear”, “3rd gear”, etc. are given their broadest reasonable interpretation to include any gear because the terms do not specify that, for example, “4th gear” corresponds to any particular speed ratio. Applicant cannot assume that the term means the 4th speed ratio either, since the claim does not state that fact. The term “shift ring” is given its broadest reasonable interpretation to include the slidable gear/dog clutch members 176 and 280. In claim 16, “restrained” is given its broadest reasonable interpretation to include members that have limited axial movement, thus including members 176 and 280.

The examiner takes Official Notice that any claimed subject matter that is not specifically addressed in the rejection of the claims is old and well known to those of ordinary skill in this art. See MPEP 2144.03

Prior Art Discussed

The examiner has considered the reference cited by applicant in his Information Disclosure Statement filed concurrently with the application. The reference was applied.

The references cited by the examiner are deemed pertinent to applicant's disclosure. They all show multiple speed counter shaft transmissions.

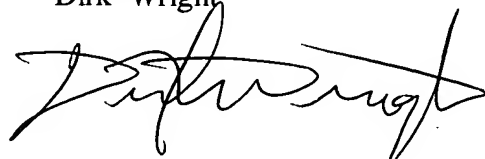
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dirk Wright whose telephone number is 571-272-7098. The examiner can normally be reached on Monday through Friday, 8AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Marmor can be reached on 571-272-7095. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Dirk Wright

A handwritten signature in black ink, appearing to read 'Dirk Wright', written over a horizontal line.

Application/Control Number: 10/764,086

Page 5

Art Unit: 3681

Primary Examiner
Art Unit 3681

DW
Friday, April 29, 2005